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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,530	12/28/2000	Denis Khoo	40015980-0007	6669
909	7590	01/02/2004	EXAMINER	
PILLSBURY WINTHROP, LLP			SALCE, JASON P	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			2611	15
DATE MAILED: 01/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/750,530

Applicant(s)

KHOO ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9-12, 17-19, 22, 44-47 and 59-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-12, 17-19, 22, 44-47 and 59-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 10/07/03 have been fully considered but they are not persuasive.

Applicant has added new limitations to the independent claims 1, 44, 59, 61 and 62 (and has added new independent claims 63 and 64, which also contain these new limitations). The added limitations do not overcome the Candelore reference for the following reasons:

The first new limitation recites, "information identifying one or more viewers requesting said motion picture content and information pertaining to the location of said content display device". Candelore discloses at Column 5, Lines 49-53 that the content display devices (terminals 160 and 170) are addressable. The examiner notes that if a terminal is addressable, then the system inherently has to receive information pertaining to that address in order to send the movie the user has requested back to his/her location. For example, some VOD systems use a TCP/IP address for each content display device (better known as a set-top box), this address must be transmitted along with the request to obtain program content so that the central facility knows where to send the data. Therefore, since the system of Candelore is addressable, this information would have to be sent to the device transmitting the motion picture content in order for the transmission device to know where to transmit the data.

The second limitation recites, "a display period sufficient for a reward". Candelore clearly recites this limitation in element 730 in Figure 7B, which states, "Has

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subscriber viewed infomercial for Z minutes?" and if the user has viewed the show for the specified time, then a coupon is awarded. Candelore also provides support in the specification at Column 6, Lines 35-36 and Column 12, Lines 10-21.

Therefore, the rejection presented in the previous Office Action stands and is repeated below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 3, 11-12, 9, 19 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3, 12, and 47, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 9, 11, 19 recite the limitation "content reception device" throughout the claims. There is insufficient antecedent basis for this limitation in the claim, because in claim 1 the applicant refers to this device as a content display device.

Claim 19 recites the limitation "reception verification data" in throughout the claim. There is insufficient antecedent basis for this limitation in the claim because claim 1 discloses display verification data instead of reception verification data. The examiner also notes that at Line 13, the claim simply states "verification data", which also lacks antecedent basis in the claim.

In regards to claim 9, the claim states, "retrieving, from the content storage device, content providing server, the content requested". The examiner cannot determine whether content is being retrieved from the storage device or the server, or if the storage device is in the server. For the remainder of this Office Action, the examiner will interpret this limitation to read, "retrieving from the content storage device, the content requested".

In regards to claim 19, the claim states, "providing the reward engine in communication with the content providing server". The examiner cannot determine what is being provided. For the remainder of this Office Action, the examiner will interpret this limitation to read, "providing data to the reward engine in communication with the content providing server".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 9-12, 17-19, 22, 44-47 and 59-64 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Candelore (U.S. Patent No. 6,057,872).

Referring to claim 1, Candelore discloses providing the motion picture content and a reward engine (see Claim 1 of Candelore). Candelore also discloses transmitting

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the motion picture content over the data network (see Claim 1 of Candelore) to a content display device (see element 160, 170 and 180 in Figure 1) the content display device having information for identifying a viewer of the motion picture content (Column 5, Lines 49-53).

Candelore also discloses displaying the motion picture content for a display period (Column 6, Lines 35-36).

Candelore also discloses transmitting over the data network, to the reward engine, a display verification data verifying that the motion picture content has been displayed by the content display device for the display period (Column 6, Lines 45-58), and providing the reward to the viewer for displaying the motion picture content (Column 5, Lines 56-63).

Candelore also discloses providing the reward to the viewer for displaying the motion picture content (Column 5, Lines 56-63).

**\*\* Applicant has added new limitations to the independent claims 1, 44, 59, 61 and 62 (and has added new independent claims 63 and 64, which also contain these new limitations). The added limitations do not overcome the Candelore reference for the following reasons:**

The first new limitation recites, "information identifying one or more viewers requesting said motion picture content and information pertaining to the location of said content display device". Candelore discloses at Column 5, Lines 49-53 that the content display devices (terminals 160 and 170) are addressable. The examiner notes that if a terminal is addressable, then the system inherently has to receive information pertaining

to that address in order to send the movie the user has requested back to his/her location. For example, some VOD systems use a TCP/IP address for each content display device (better known as a set-top box), this address must be transmitted along with the request to obtain program content so that the central facility knows where to send the data. Therefore, since the system of Candelore is addressable, this information would have to be sent to the device transmitting the motion picture content in order for the transmission device to know where to transmit the data.

The second limitation recites, "a display period sufficient for a reward". Candelore clearly recites this limitation in element 730 in Figure 7B, which states, "Has subscriber viewed infomercial for Z minutes?" and if the user has viewed the show for the specified time, then a coupon is awarded. Candelore also provides support in the specification at Column 6, Lines 35-36 and Column 12, Lines 10-21.

Referring to claim 2, Candelore discloses providing a motion picture advertisement (Column 6, Lines 51-55).

Referring to claim 3, Candelore also discloses providing a movie (Column 8, Lines 33-38).

Referring to claim 9, Candelore discloses providing a content storage device, the content storage device containing the motion picture content (Column 7, Lines 23-27).

Candelore also discloses requesting over the data network, by the content display device (Column 10, Lines 18-31), the motion picture content from a content providing server (see element 130 (controller) in Figure 1), the content providing server

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being in communication with the content storage device (see element 140 in Figure 1 and Column 7, Lines 23-27).

Candelore also discloses retrieving, from the content storage device, by the content providing server (Column 7, Lines 31-33), the motion picture content requested (Column 3, Lines 9-17).

Candelore also discloses transmitting the motion picture content to the content display device (element 120 in Figure 1), the motion picture content being transmitted from the content storage device, to the content providing server (Column 6, Lines 17-21 and element 120 and 140 in Figure 1) and then to the content display device through the data network (element 170 in Figure 1).

Referring to claim 10, Candelore discloses transmitting the information to the content providing server (Column 7, Lines 31-33) in the step of requesting the motion picture content from the content providing server (Column 3, Lines 9-17), and storing the information in a viewer information database (element 125 in Figure 1), the viewer information database being in communication with the content providing server (element 120 in Figure 1).

Referring to claim 11, Candelore discloses that the content display device requests the motion picture content based on a demographic of the viewer (Column 17, Lines 65-67 and Lines 1-2).

Referring to claim 12, Candelore discloses displaying the motion picture content on an intelligent television (element 180 in Figure 1).



Referring to claim 17, Candelore discloses displaying the motion picture content for the display period, the display period being a period of time to display a portion of the motion picture content (Column 6, Lines 35-36).

Referring to claim 18, see rejection of claim 17.

Referring to claim 19, Candelore discloses providing the reward engine in the communication with content service provider (elements 120 and 135 in Figure 1).

Candelore discloses identifying, to the reward engine through the display verification data, the motion picture content being displayed (Column 6, Lines 35-36).

Candelore discloses identifying, to the reward engine through the display verification data, the viewer information to identify the content display device displaying the motion picture content (Column 5, Lines 49-53 and Column 6, lines 38-41).

Referring to claim 22, Candelore discloses providing a monetary award to the viewer (Column 9, Lines 7-14).

Referring to claim 44, see rejection of claims 1 and 9.

Referring to claim 45, Candelore discloses that the content display device requests the motion picture content based on a viewing habit of the viewer (Column 2, Lines 55-61).

Referring to claims 46-47, see rejection of claims 11-12, respectively.

Referring to claims 59-64, see rejection of claims 1 and 9.

### ***Conclusion***

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

December 29, 2003

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
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